

Remarks

The Restriction Requirement dated August 3, 2009, has been received and carefully reviewed. By this response, claims 1-21, 23 and 32 are amended. Claims 30-31 are cancelled without prejudice or disclaimer. Support for the amendments can be found, *inter alia*, at original claims 15 and 22, as well as in the specification, e.g. paragraphs [0004], [0016], [0018], [0030] and [0074]. No new matter is added. Accordingly, claims 1-29 and 32-37 are pending in the application.

Applicant hereby elects with traverse, to prosecute Group IA, comprising claims 2, 3, and 32. Additionally, by this amendment, claims 6-8 have been amended to depend directly or indirectly from claim 2 and therefore, should be considered part of Group IA and prosecuted therewith.

The Office Action required restriction of the claims to 11 different groupings (IA-IF and IIA-IIE). Claims 1, 15 and 30 were determined to be linking claims. However, the Office Action asserts that claims 1, 15 and 30 lack novelty and inventive step and therefore do not contribute over the prior art. As already noted, the Applicant traverses the restriction requirement.

Claims 1 and 15, as amended, recite subject matter not disclosed or rendered obvious by the cited prior art and are drawn to the same inventive concept

Claim 1 defines a method for producing a grating image of a security element, which at least has one grating field separately perceptible with the naked eye. The method includes steps defining a contour line of the grating field, filling the contour line with the grating pattern (the grating pattern within the contour line being described by grating coordinates), supplying the grating coordinates to a writing apparatus and

producing the grating pattern in a substrate with the writing apparatus and with the help of the grating coordinates.

Claim 15 defines a grating image of a security element, which has at least one image field separately perceptible with the naked eye, in which a grating pattern consisting of not interrupted grating lines is disposed, which is produced by means of a lithography instrument.

In contrast to the method of amended claim 1, the diffraction grating of Toshihiko is an “optional coupler to direct the fundamental mode of light into an optical waveguide” (col. 1, l.64-66 of Toshihiko) and not a security element. That is, the skilled person dealing with security elements for security documents would certainly not consider Toshihiko. Moreover, there is no disclosure of a contour line of the grating field being defined in Toshihiko. Accordingly to the present application, such a contour line may define an area of arbitrary shape (see, e.g., Fig. 4, 6 of the present application) to be filled with a grating pattern. The shape of the diffraction grating according to Toshihiko (a basically rectangular area of size ca. 1mm by 760 μm) appears to be predefined by the respective optical requirements (see, col. 5, l.3-14, Fig. 2A of Toshihiko).

Susumu fails to anticipate the claimed invention and does not cure the deficiencies of Toshihiko. No security elements or the like having a diffraction grating is disclosed or suggested in Susumu. As regards the diffraction grating produced by the method of JP 09 230122 A (Susumu), this grating consist of dots of very small size. The pitch of the dots is described to be 0.1 mm or less. That is, the dots cannot be observed independently and are certainly separately perceptible with the naked eye

(see, paragraph [0005] of the machine translation of Susumu, which is also attached hereto).

Prior art of this kind, i.e., prior art teaching to provide a diffraction grating that is composed of dots of small size, has already been discussed in the specification of the present application (e.g., see, paragraphs [0013, 0014] of the application), as well as the respective drawbacks thereof. According to the claimed methods of the present application, these drawbacks can be overcome, resulting in grating images having increased light intensity and no distortion of colors due to the large image areas that are not composed of small surfaced dots with interfering spaces (see, e.g., paragraph [0018] of the present application).

Thus, the subject matter of claims 1 and 15 are patentable over the cited prior art. Accordingly, Applicant requests that the restriction requirement be withdrawn as claims 1-29 and 32-37 are drawn to a single inventive concept under PCT Rule 13.1.

In view of the above, all objections and rejections have been sufficiently addressed. The Applicant submit that the application is now in condition for allowance and request that claims 1-29 and 32-37 be allowed and this application passed to issue.

In the event that this paper is not timely filed, the Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account No. 02-2135.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by

telephone, the Applicant's undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

Respectfully submitted,

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Date

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